

### **REMARKS**

Claims 1-6 have been amended and claims 7-11 stand cancelled. New claims 12-14 have been added. No new matter has been added by virtue of the within amendments; support therefor can be found throughout the specification and original claims of the application. For instance, the amendments to claims 1 to 6 are supported by the specification in that water is not added to any adhesive patches of the invention. Thus, the present claims have been amended to recite that the patches are 'non-aqueous'. The amendments to claims 12 and 13 are supported by the disclosure at least at Paragraph Nos. [0019] to [0032]. Support for new claim 14 can be found, e.g., in the specification at Paragraph No. [0035].

#### **Information Disclosure Statement**

As an initial matter, it is noted that the PTO/SB08 Form attached to the Office Action indicates that Japanese references BA-BJ cited in the Information Disclosure Statement (IDS) which was filed with the original application on March 17, 2006, were not considered. The Examiner indicates that "None of these references have any part that is in English". That said, the Examiner cited English translations of references BA-BC on Form PTO-892. Accordingly, a Supplemental IDS is being filed concurrently herewith and English Abstracts are provided for the remaining references, BD-BJ.

#### **Claim Rejections - 35 USC §102**

Claims 1, 2, 7-9 and 11 stand rejected under 35 USC §102(b) over the English translation of JP07-048554 ('554).

The rejection is traversed. The cited document does not teach or suggest the features of the present invention in any manner sufficient to sustain the rejection.

However, without acquiescing to the grounds for the rejection, Applicant submits that the within amendments obviate the rejection. In particular, the present claims now recite a non-aqueous adhesive patch. In contrast, the '554 reference discloses an adhesive tape or sheet with an emulsion type acrylic pressure sensitive adhesive

composition. The skilled artisan will appreciate that the term "emulsion type" means that the composition disclosed in the '554 reference contains a significant amount of water. Indeed, Example 1 of the '554 reference contains the ion-exchange-water 50 weight part and Example 4 shows that emulsion polymerization is carried out as Example 1.

For at least that reason, the present invention is distinct from that taught by the '554 reference.

Accordingly, the rejection is properly withdrawn. For example, see *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978) ("[r]ejections under 35 U.S.C. §102 are proper only when the claimed subject matter is identically disclosed or described in the prior art.")

#### Claim Rejections - 35 USC §103

Claims 1 and 4-6 stand rejected under 35 USC §103(a) over the English translation of JP 2,632,838 B2 ('838) in view of the English translation of JP 08-081331 A ('331).

Claims 3 and 10 stand rejected under 35 USC §103(a) over the '554 reference in view of the definition of "fatty acid" (Hawley's Condensed Chemical Dictionary, 14<sup>th</sup> edition, 2002).

The rejections are traversed. The cited references, even in the stated combinations, do not teach or suggest the features of the present invention and are insufficient to sustain the rejections.

For instance, the '838 reference discloses a polymer base composition containing a water absorbing polymer. Applicant refers to the '838 reference at page 2, column 4, lines 23 to 50 which describes the '838 reference's water absorbing polymer in detail and notes the corresponding English translation appears at page 3, line 22. Particularly, see the text in the English translation at page 3, line 22, beginning with ("Next, if a water absorption polymer is explained concretely...") and continuing on to

page 4, line 7, ending with ("... 100micro or less is specifically 30micro or less especially preferably").

Applicant offers a more precise English translation of the passage which corresponds to lines 22 to 25, and which ends just before "for Example, Mitsuhiro..." at line 25.

The water absorbing polymer is explained in detail. The water absorbing polymer is a polymer which is able to absorb an amount of water which is 10 times or more of the weight of polymer itself and to swell to be a gel containing water. For example, one or more water soluble polymer into which cross-linking bonds are introduced is formulated.

Applicant notes that the sucrose fatty acid ester is not a water absorbing polymer as taught by the '838 reference. Indeed, the sucrose fatty acid ester of the present invention is not a polymer compound, but rather an ester compound and it does not absorb water.

In that respect, the Examiner points to the '331 reference as teaching that "sucrose fatty acid esters excel at absorbing sweat and sebum but the resulting solid composition has excellent durability and resists water". Applicant offers a more precise English translation of Paragraph No. [0006] of the '331 reference which reads as follows:

According to the inventor's finding, the blending of sucrose fatty acid esters into cosmetics makes the cosmetics excel at absorbing sweat and sebum, thereby the adherence of the cosmetics to skin is not reduced, and solid cosmetics having excellent water resistance durability are obtained.

Thus, Applicant submits that the '331 reference does not teach or suggest that the sucrose fatty acid ester is a water absorbing material.

Further, Paragraph No. [0016] of the '331 reference is more precisely translated as follows:

It is thought that hydrophilic sucrose fatty acid esters do not form a stable emulsified fat due to its having too much hydrophilicity. Thus, hydrophobic sucrose fatty acid esters are to be used in the present invention.

Accordingly, it is respectfully submitted that the '331 reference does not teach or suggest that a sucrose fatty acid ester having more hydrophilicity should be used in cosmetics.

Since the '838 reference requires a water absorbing polymer as explained above, one skilled in the art would not be motivated to combine the '838 and '331 references. Even assuming *arguendo* that were the case, such a combination still would not result in the present invention.

For at least the foregoing reasons, Applicant submits that the present invention is not obvious over the '838 reference in view of the '331 reference.

Further, the present invention also is not rendered obvious by the '554 reference and "Hawley's Condensed Chemical Dictionary" because the sucrose fatty acid ester is not used as a water absorbing polymer; the dictionary passage merely exemplifies sugar fatty acid esters.

Accordingly, each of the rejections under §103(a) is properly withdrawn. For instance, it is well-known that to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference(s) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143.

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the cited references to make the claimed invention, nor is there a reasonable expectation of success. Accordingly, reconsideration and withdrawal of the rejection are requested.

Double Patenting

Lastly, the Office Action advises that should claims 1-3 and 7 be found allowable, claims 8-11 will be objected to under 37 CFR 1.75 as allegedly being a substantial duplicate thereof. Applicant has cancelled claims 8 to 11, thus avoiding any such prospective objection.

In view of the above amendments and remarks, Applicant believes the pending application is in condition for allowance.

### **FEE AUTHORIZATION**

The Commissioner is authorized to charge any fees associated with this submission (including the fee for the IDS being concurrently filed with this Amendment) to our Deposit Account, No. 04-1105, Reference 64927(71526). Any overpayment should be credited to said Deposit Account.

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Respectfully submitted,



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